

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-39 and 41-57 are currently pending. Claims 3, 4, 35-39, and 57 are hereby canceled. Claims 1, 6, 7, 20-22, 25-30, 32, 34, 41-43, 45, 47-49, 53, and 54 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

II. OBJECTIONS TO THE INFORMATION DISCLOSURE STATEMENT

Numbered paragraph 2, on page 2, of the Office Action indicates that the Information Disclosure Statement (IDS) filed on April 14, 2006 fails to comply with 37 CFR 1.98(a)(2) for failing to provide a legible copy of each foreign patent document. Specifically, the Office Action indicates foreign references EP 0 034 185 and DE 93 12 966 have not been considered.

In response, Applicants submit a Supplemental IDS with this paper including the above indicated references.

Applicants respectfully submit the IDS in this application conforms with 37 CFR 1.98(a)(2) and requests consideration and entry of the foreign references cited therein.

III. OBJECTIONS TO THE SPECIFICATION

Numbered paragraph 3 on page 2 of the Office Action objects to the disclosure for a formality, specifically, a typographical error at page 17, line 10 (incorrectly indicated as line 20 in the Action). As indicated above in the section identified as “Amendments to the Specification,” the disclosure is presently amended, making the objection moot.

Applicants respectfully request reconsideration and withdrawal of the objection to the specification in this application.

IV. OBJECTIONS TO THE CLAIMS

Numbered paragraph 4, on pages 2-4 of the Office Action, objects to claims 6, 7, 25, 30, 32, 34-36, 47, 48, 53, and 57 for various informalities.

As indicated above in the listing of the claims, claims 6, 7, 25, 30, 32, 34, 47, 48, and 53 are presently amended, and claims 35, 36, and 57 cancelled, making moot the objections.

Applicants respectfully request reconsideration and withdrawal of the objections to the claims in this application.

V. REJECTIONS UNDER 35 U.S.C. §112

Numbered paragraph 6 on page 4 of the Office Action rejects claims 1-39, 45, 47, and 49 under 35 U.S.C. § 112, second paragraph, as being indefinite.

As indicated above in the listing of the claims, claims 1, 6, 7, 20, 21, 22, 25-30, 32, 34, 45, and 49 are presently amended and claims 35-39 are presently cancelled, making moot the rejections.

Applicants respectfully request reconsideration and withdrawal of the rejection under § 112, second paragraph, in this application.

VI. REJECTIONS UNDER 35 U.S.C. § 102

Claims 41-43, 45, 47, 50, and 53-57 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,599,829 to DiMartino, Sr. et al. ("DiMartino").

Claims 35-37 and 39 were rejected under §102(b) as allegedly anticipated by U.S. Patent No. 5,072,845 to Grogan ("Grogan").

Applicant respectfully traverses for at least the following reasons.

Initially, as indicated in the listing of claims above, claims 35-37 and 39 are presently cancelled, making moot the rejections based on Grogan.

Independent claim 41, as presently amended, recites, *inter alia*:

A multiplicity of modules...including a **plurality of fastening elements that are adapted to fasten each module to other modules.** (Emphasis added.)

As claimed, the modules include a **plurality of fastening elements that are adapted to fasten each module to other modules.** As such, the claimed fastening elements are adapted to fasten each module to more than one other module. This feature is neither disclosed in DiMartino.

In contrast, as understood by the Applicants, DiMartino discloses a building system in which connectors are used to vertically mount a container unit to a base below for a first level, or, for the second and subsequent levels, the connector connects an upper unit to a lower unit. *DiMartino*, Figs. 3-7 and column 7, lines 4-27.

Therefore, DiMartino fails to anticipate the modules of claim 41 because the reference fails to disclose at least a **plurality of fastening elements that are adapted to fasten each module to other modules** as recited in claim 41.

Claim 54 recites a module including **first and second sets of fastening elements compris[ing] more than two fastening elements at locations spaced across the top of the**

module, each fastening element being spaced from another fastening element at a centre-to-centre spacing of about 2260 mm.

As understood by applicants, DiMartino discloses building container units comprising standard I.S.O trailer shipping containers fitted with standard I.S.O corner fittings.

DiMartino, column 3, lines 38-45. Each unit is formed with four I.S.O. standard bottom corner fittings and four I.S.O. standard top corner fittings. *Id.*, column 5, lines 24-33.

Accordingly, the building container units disclosed are limited to the standard I.S.O. size containers.

In contrast, the claimed building modules may be comprised of non-standard, larger modules with fastening elements spaced at about 2260 mm, the spacing for standard I.S.O. corner fittings. Therefore, the non-standard sized modules may be transported with standard load handling apparatus.

Therefore, because DiMartino is limited to standard I.S.O. containers with standard corner fittings spaced at about 2260 mm, the reference fails to disclose **more than two fastening elements at locations spaced across the top of the module, each fastening element being spaced from another fastening element at a centre-to-centre spacing of about 2260 mm** as claimed.

Applicants respectfully request reconsideration and withdrawal of the rejections based on DiMartino in this application.

VII. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-10, 17-21, 30, and 34 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,072,845 to Grogan (“Grogan”).

Claims 11-16 were rejected under 35 U.S.C. § 103(a) over *Grogan* in view of U.S. Patent No. 5,706,614 to Wiley et al. (“Wiley”).

Claims 23 and 24 were rejected under 35 U.S.C. § 103(a) over Grogan in view of U.S. Patent No. 3,752,511 to Racy ("Racy").

Claims 27 and 28 were rejected under 35 U.S.C. § 103(a) over Grogan in view of U.S. Patent No. 3,722,714 to Morris et al. ("Morris").

Claims 29 and 38 were rejected under 35 U.S.C. § 103(a) over Grogan in view of European Application Patent No. EP 0175446 to Robishaw et al. ("Robishaw").

Claims 31-33 were rejected under 35 U.S.C. § 103(a) over Grogan in view of U.S. Patent No. 6,381,977 to Austin, Jr. ("Austin").

Claim 44 was rejected under 35 U.S.C. § 103(a) over DiMartino.

Claim 46 was rejected under 35 U.S.C. § 103(a) over DiMartino in view of Patent No. 6,155,747 to Payne et al. ("Payne").

Claim 48 was rejected under 35 U.S.C. § 103(a) over DiMartino in view of Patent No. 6,877,939 to Tomkins et al. ("Tomkins").

Claims 22, 23, 25, 26, and 49 were rejected under 35 U.S.C. § 103(a) over Grogan in view of DiMartino.

Claims 51 and 52 were rejected under 35 U.S.C. § 103(a) over DiMartino in view of Morris.

Numbered paragraph 30, beginning on page 8 of the Office Action, asserts that Grogan discloses an overall exterior width of greater than 96 inches and specifically, 102 inches, and further asserts that the claimed width to be a matter of design choice. Applicants respectfully traverse for at least the following reasons.

As presently understood, Grogan is directed to modular cargo containers adapted to be mounted on a standard truck-trailer chassis or a railway flat car. *Grogan*, column 1, lines 6-9. In particular, Grogan is concerned with securing a 102 inch wide cargo container on a

truck frame or railroad car designed for the standard 96 inch wide containers. *Id.*, column 2, lines 58-62.

Independent claim 1 presently recites, *inter alia*,

A building module...wherein the module has an overall exterior width greater than 2700 mm and includes a first set of fastening elements in the region of a first end of the top of the module and a second set of fastening elements in the region of a second end of the top of the module...and wherein each of the first and second sets of fastening elements comprises more than two fastening elements at locations spaced across the top of the module, each fastening element being spaced from another fastening element at a centre-to-centre spacing of about 2260 mm, and wherein each of the first and second sets of fastening elements includes fastening elements at the opposite side edges of the top of the module.

As claimed, the building module has an overall width greater than 2700 mm and fastening elements spaced across the top of the module with a spacing of about 2260 mm. Applicants submit that the claimed size and spacing are not merely design choices. With the specified dimensions, even the narrowest claimed width each end of the module would include a third fastening element. A first set of fastening elements with a spacing of about 2260 mm, with one of the elements at a side edge of the module, would place the second element of the first set about 440 mm from the other side edge. However, as claimed, **each of the first and second sets of fastening elements includes fastening elements at the opposite side edges of the top of the module** placing an additional fastening element on each side edge of the top of the module.

Grogan adapts cargo containers with widths up to 102 inches (2590 mm) to fit ISO standard truck or train frames. In contrast, the inventive building module denies the teaching of the ISO standard width and specifies modules wider than 2700 mm (106.3 inches) that can still be handled by standard load handling equipment. At the wider widths, it is advantageous to provide additional fastening elements at the side edges.

Because Grogan fails to disclose or render predictable containers with an **exterior width greater than 2700 mm and first and second sets of fastening elements includ[ing] fastening elements at the opposite side edges of the top of the module** as claimed, Applicants respectfully submit that the claimed building module is not obvious in view of the reference.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the §103 rejections in this application.

VIII. DEPENDENT CLAIMS

The remaining pending claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

The Examiner has made of record, but not applied, several documents. The Applicants appreciate the Examiner's implicit finding that these documents, whether considered alone or in combination with others, do not render the claims of the present application unpatentable.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

CONCLUSION

In view of the foregoing, it is believed that the present application is in condition for allowance. Accordingly, Applicants' attorneys respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By:



Ronald R. Santucci
Reg. No. 28,988

Frederick W. Dour
Reg. No. 39,174

Telephone: (212) 588-0800
Facsimile: (212) 588-0500